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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,332	03/08/2004	Michael Lax	AUT/008 CONT	2003

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EXAMINER	
GALL, LLOYD A	

ART UNIT	PAPER NUMBER
3676	

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/796,332	LAX ET AL.	
	Examiner	Art Unit	
	Lloyd A. Gall	3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 December 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *82-108 and 120-150* is/are pending in the application.

4a) Of the above claim(s) *97,99,100,139,141 and 142* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *82-96,98,101-108,120-138,140 and 143-150* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *08 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Applicant's election of the storage case species 1 (figs. 1-22) and the lock species 1 (figs. 12-16e) in the reply filed on December 23, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 97, 99, 100, 139, 141, 142 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on December 23, 2004.

Claims 82-96, 98, 101-108, 120-138, 140 and 143-150 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 26, 42, 43, 49, 50 and 82 of copending Application No. 09/858,457. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of the claims of this application is substantially contained in the claims of the (457) application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 82-96, 98, 101-108, 120-138, 140 and 143-150 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 10/775,259. Although the conflicting claims are not identical, they are not patentably distinct from each other

because the subject matter of the claims of this application is substantially contained in the claims of the (259) application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 82-96, 98, 101-108, 120-138, 140 and 143-150 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-130 of copending Application No. 10/723,911. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of the claims of this application is substantially contained in the claims of the (911) application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 82-96, 98, 101-108, 120-138, 140 and 143-150 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 26-55 of copending Application No. 10/817,713. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of the claims of this application is substantially contained in the claims of the (713) application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant is required to maintain a clear line of demarcation between the claims of the instant application and the claims of all other applications, or file a terminal disclaimer.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 82, 86, 88-90, 106 and 107 are rejected under 35 U.S.C. 102(b) as being anticipated by Bruhwiler (086).

Bruhwiler teaches a containing element 1 capable of enclosing an item 2, a lock having a base 3 with a portion 3b configured to move inside the containing element 1, and a catch 3d attached to the portion 3b and movable by a magnetic decoupler relative to the portion 3b. As seen in figs. 2a and 3, the catch 3d moves between first and second positions when actuated by the magnetic field. With respect to claims 89 and 90, it is

submitted that the item is not positively being claimed, and that the item of Bruhwiler may also be regarded as a storage and recording medium.

Claims 82, 85, 86, 88-92, 94-96 and 105-107 are rejected under 35 U.S.C. 102(b) as being anticipated by Holmgren (315).

Holmgren teaches a containing element 10, 40, 41, 23, 25 capable of enclosing an item therein, which item is not being positively claimed, and may be regarded as a storage or recording medium. Holmgren also teaches a lock in figs. 3 and 6 including a base 14, 16 having a portion 17 or 20 which is configured to move inside the containing element as seen in fig. 6, and a first catch 22 configured to move by a magnetic field. With respect to claim 85, the catch 22 is urged outwardly by the magnet as seen in fig. 6. As seen in fig. 6, the catch moves between first and second positions inside the containing element. With respect to claim 95, the catch 22 in fig. 3 is capable of being bent downwardly beyond the periphery of the of the body 14, 16. Portions 40, 41 define an indent, with respect to claim 96. With respect to claim 105, portion 16 may be used as a handle.

Claims 82-86, 88-92, 94-96, 101-108, 120-125, 127-134, 136-138 and 143-150 are rejected under 35 U.S.C. 102(b) as being anticipated by Burdett et al (185).

As seen in figs. 1 and 23, Burdett teaches a containing element with hinged portions 12, 14, hubs 16, a lock having a base portion 212 in fig. 24 received within a portion 72 of the containing element, or a base 212 having a portion 214 received within the containing element, first and second catch mechanisms 216 having a portion 242 which is urged/actuated toward the outside of the containing element by a magnetic field. The

item is not regarded as being positively claimed, and may also be regarded as a storage/recording medium. With respect to claim 91, the catch portion is movable to a fig. 23 position which does not extend beyond the peripheral portion 212 of the base. With respect to claim 95, portion 216 extends beyond the periphery 212 of the base as seen in fig. 24. As seen in the fig. 2 open condition, the notches on the side walls 20 are regarded as an indent capable of receiving one's finger. With respect to claim 102, portion 218 receives a security tag 220 in fig. 23 inside portion 72 of the containing element. Holes 62, 68 define loops to receive portion 214 of the lock. Portion 112 of the lock may be regarded as a handle.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 87, 93, 126 and 135 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Bruhwiler, Holmgren or Burdett et al, in view of Lax (922). Lax teaches a metal pin 62 actuated by a magnet. It would have been obvious to modify the magnetically attracted material of Bruhwiler, Holmgren and Burdett to be metal, in view of the teaching of Lax, to ensure that the material is always attracted when actuated by the magnet.

Claims 98 and 140 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burdett et al in view of Belden et al (788).

Belden teaches a document retaining member 26 on a storage case. It would have been obvious to provide a document retaining member in the case of Burdett et al, in view of the teaching of Belden et al, the motivation being to enable the case to firmly hold documents therein.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lloyd A. Gall whose telephone number is 703-308-0828 and after April 2005 at 571-272-7056. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 703-308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LG LG

March 28, 2005

Lloyd A. Gall
Primary Examiner